

REMARKS

The claims have been amended to point out that the adhesive is positioned between two members, and bonds these members together. Support for this amendment can be found throughout the specification and claims, and mores specifically at page 18, lines 6-10, wherein it is recited that an adhesive solution may be applied at a seam between interlocking seaming members.

Claim 7 has been cancelled and its place, new claim 21 has been added, including the recitations of claims 1 and 7 therein. In view of the Examiner's statement in the Office Action that claim 7 contains allowable subject matter and would be allowable if rewritten in independent form, Applicants have amended claim 7 by incorporating the subject matter of claims 1 and 7 therein in new claim 21.

Entry of the above amendments is respectfully requested. Review and reconsideration on the merits are further requested.

Claims 1, 3-6, 8-13, 17 and 20 have been rejected under 35 U.S.C. §102(b) as anticipated by Okunuki, et al. In response, Applicants traverse the rejection.

The Examiner states that the preamble claiming an adhesive alone has little probative value. In response, Applicants have amended claims 1 and 20 to recite that the adhesive is positioned between first and second members, and the adhesive bonds said first member and said second member. Therefore, the present claims are directed to an adhesive positioned between first and second members and bonding those members together.

Okunuki, et al., other the other hand, does not teach or suggest an adhesive comprising a polyamide and electrically conductive filler. Instead, Okunuki, et al. teaches a surface layer comprising a polyamide. Applicants refer to Okunuki, et al. at column 3, lines 37-47 wherein it is recited that a surface layer comprises nylon, or substituted nylon. Also, Okunuki, et al. does not teach or suggest an alcohol-soluble polyamide, as claimed. Therefore, because Okunuki, et al. does not teach or suggest the elements of the claims, Applicants submit that the claims are not anticipated by Okunuki, et al.

In addition, Applicants submit that the present claims, as amended, are not obvious in view of the reference. Applicants submit that one of ordinary skill in the art faced with the teachings of Okunuki, et al. of using a polyamide as the surface layer, would not have been motivated to use an alcohol-soluble polyamide as an adhesive layer, present between first and second members, and bonding these members together, absent some teaching or suggestion. Further, Applicants submit that one of ordinary skill in the art would not have been motivated to use an alcohol-soluble polyamide absent some teaching or suggestion. Accordingly, Applicants submit that the present claims are also not rendered obvious in view of the teachings of Okunuki, et al.

In view of the above arguments, Applicants request withdrawal of the rejection of claims 1,3-6, 8-13, 17 and 20 under 35 U.S.C. §102(b) as anticipated by Okunuki, et al.

Claims 1, 3-6, 8, 9, 11, 13 and 20 have been rejected under 35 U.S.C. §103(a) as obvious over Jung, et al. in view of Nakamura, et al. In response, Applicants traverse the rejection.

Jung, et al. teaches at column 3, starting at line 40, a transference medium which can be used as an adhesive. The transference medium can comprise polyamide and a "conducting medium disbursed therein." The present claims, on the other hand, recite a polyamide as an alcohol-soluble polyamide. Jung, et al. does not teach or suggest use of an alcohol-soluble polyamide as an adhesive.

The Examiner turns to Nakamura, et al. as teaching an alcohol-soluble polyamide as an adhesive. At column 8, lines 21 and 22, Nakamura, et al. teaches an alcohol-soluble amide, and a polyamide, as examples of adhesive materials in a photoreceptor member. In example 1 of the reference, an alcohol-soluble polyamide is mixed with methanol and butanol and a Nylon-6 resin and used as a subbing layer for a photoreceptor member. Nakamura, et al. does not teach or suggest that an electrically conductive filler can be used in combination with the alcohol-soluble polyamide adhesive as claimed.

Applicants submit that one of ordinary skill in the art would not have been motivated to combine the references. In addition, Applicants point out that the Examiner has not provided any evidence in the references showing motivation. The Examiner just states that the references should be combined, because Jung, et al. teaches a polyamide adhesive and because the use of an alcohol-soluble polyamide as an adhesive is well known in the art. The Examiner has not cited any evidence that would have motivated one of ordinary skill to combine the references. Therefore, a *prima facie* case of obviousness has not been made.

Applicants submit that one of ordinary skill in the art would not have been motivated to combine the references cited. Again, Jung, et al. teaches a polyamide and electrically conductive filler adhesive, but does not does not teach an alcohol-soluble polyamide. Nakamura, et al. teaches an alcohol-soluble polyamide as an adhesive, but does not teach or suggest an electrically conductive filler. Applicants point out that Jung, et al. relates to electrodes and electrochemical cells and methods for making them. On the other hand, Nakamura, et al. teaches electrophotographic apparatus, and in particular, photosensitive members or photoreceptors. Applicants submit that one of ordinary skill in the art looking for an adhesive would not have been motivated to combine the teachings of a reference discussing electrodes and electrochemical cells, with a reference discussing photoreceptors. The references are not in the same field of endeavor.

In view of the above arguments, Applicants submit that the present claims are not rendered obvious in view of the cited combination. Accordingly, Applicants request withdrawal of the rejection of claims 1, 3-6, 8, 9, 11, 13 and 20 under 35 U.S.C. §103(a) as obvious over Jung, et al in view of Nakamura, et al.

Claims 1, 3-6, 8, 14-18 and 20 have been rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Fuller, et al. or Dinh, et al. In response, Applicants traverse the rejection.

Applicants point out that the present claims have been amended to recite an adhesive material positioned between first and second members, wherein the adhesive bonds said first and second members.

Fuller, et al. teaches the use of polyamide as an overcoat for an imaging member, and not as an adhesive material positioned between first and second members and bonding those members, as claimed. The overcoat is taught at column 17, beginning at line 36 of Fuller, et al. as including arylamine charged transport molecules. There is no teaching or suggestion in the reference to use an alcohol-soluble polyamide as an adhesive as claimed. Instead, Fuller, et al. teaches use of an alcohol-soluble polyamide as an overcoat for an imaging member. In addition, Fuller, et al. does not teach or suggest use of electrically conductive fillers in combination with an alcohol-soluble polyamide as an adhesive as claimed. There is no teaching or suggestion of use of electrically conductive fillers in combination with an alcohol-soluble polyamide. Therefore, because Fuller, et al. does not teach or suggest use of an alcohol-soluble polyamide as an adhesive, and further because Fuller, et al. does not teach or suggest use of electrically conductive fillers in combination with an alcohol-soluble polyamide as an adhesive, Applicants submit that the present claims are not anticipated by or rendered obvious in view of the reference.

Turning to Dinh, et al., this reference also teaches use of diarylamine small molecule charge transport material as a layer in an imaging member. The reference does not teach or suggest the use of an alcohol-soluble polyamide and electrically conductive fillers as an adhesive positioned between first and second members, wherein the adhesive bonds said first and second members, as claimed. As with Fuller, et al., Dinh, et al. does not teach or suggest use of electrically conductive fillers in combination with the alcohol-soluble polyamide as an adhesive, and further does not teach or suggest use of the alcohol-soluble polyamide as an adhesive. Because Dinh, et al. does not teach or suggest the elements of the present claims, Applicants submit that the present claims are not anticipated by or rendered obvious in view of the reference.

Further, because the combination cited does not teach the claimed adhesive comprising electrically conductive filler, Applicants submit that the present claims are not obvious in view of the cited combination.

In view of the above arguments, Applicants submit that the present claims, as amended, are not anticipated by nor rendered obvious in view of the references. Accordingly, Applicants request withdrawal of the rejection of claims 1, 3-6, 8, 14-18 and

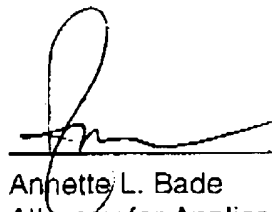
20 under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Fuller, et al. or Dinh, et al.

In view of the above arguments and amendments, Applicants submit that all claims should now be in condition for allowance. Early indication of allowability is respectfully requested.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation Attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

In the event the Examiner considers personal contact advantageous to the disposition of this case, s/he is hereby authorized to call Applicant's Attorney, Annette L. Bade, at telephone number (310) 333-3682, El Segundo, California.

Respectfully submitted,



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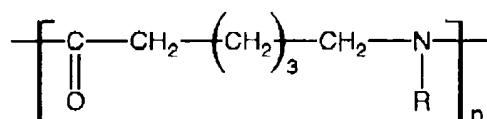
VERSION WITH MARKINGS TO SHOW CHANGES MADE:

IN THE CLAIMS:

1. (Twice Amended) An adhesive material positioned between first and second members, wherein said adhesive bonds said first member and said second member, said adhesive comprising an alcohol-soluble polyamide and electrically conductive filler.

Claim 7 has been cancelled.

20. (Twice Amended) An adhesive material positioned between first and second members, wherein said adhesive bonds said first member and said second member, said adhesive comprising an alcohol-soluble polyamide having the following general formula:



wherein R is selected from the group consisting of hydrogen; alkyl having from about 1 to about 20 carbons, alkoxy having from about 1 to about 20 carbons, alkyl alkoxy having from about 1 to about 20 carbons, and alkylene alkoxy having from about 1 to about 20 carbons, and wherein n is a number of from about 50 to about 1,000.

Claim 21 is a new claim.

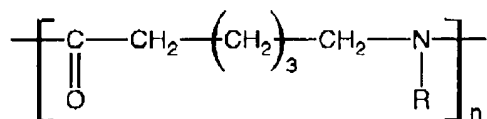
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1. (Twice Amended) An adhesive material positioned between first and second members, wherein said adhesive bonds said first member and said second member, said adhesive comprising an alcohol-soluble polyamide and electrically conductive filler.

Claim 7 has been cancelled.

20. (Twice Amended) An adhesive material positioned between first and second members, wherein said adhesive bonds said first member and said second member, said adhesive comprising an alcohol-soluble polyamide having the following general formula:



wherein R is selected from the group consisting of hydrogen; alkyl having from about 1 to about 20 carbons, alkoxy having from about 1 to about 20 carbons, alkyl alkoxy having from about 1 to about 20 carbons, and alkylene alkoxy having from about 1 to about 20 carbons, and wherein n is a number of from about 50 to about 1,000.

Claim 21 is a new claim.